

REMARKS

In the Election of Species Requirement dated July 13, 2006, the Examiner required election to one of the following groups: Group I (i.e., claims 2-15 and 17) drawn to a method of photoresist trimming, classified in class 438 subclass 725; and Group II (i.e., claims 19 and 20) drawn to a trim gas, classified in class 252 subclass 186.1+. The Examiner also asserted that if Group I is elected, then Applicants are further required to elect between Species I, drawn to a photoresist trimming process requiring the removal of a resist foot in a trench, and Species II, drawn to forming an image mask. The Examiner additionally asserted that no claims are generic.

While the Examiner has alleged the inventions are distinct, this alone is not sufficient to support a Restriction Requirement. In particular, Applicants respectfully submit that the Examiner's restriction fails to identify one of the two criteria for a proper restriction requirement established by the U.S. Patent and Trademark Office policy. As set forth in M.P.E.P. §803, "**an appropriate explanation**" must be advanced by the Examiner as to the existence of a "**serious burden**" if the restriction requirement were not required. The instant restriction requirement merely alleges a possible distinction between the two identified groups of invention, but fails to provide any facts to show that a concurrent examination of these groups by the Examiner would present a "serious burden."

Applicants submit that there is no undue or serious burden in concurrently examining Groups I and II because **the Examiner has already examined the groups together**, as evidenced by the Office Action dated January 10, 2006. That is, the Office Action dated January 10, 2006 treated claims 1-20 on the merits. It is presumed that the Examiner performed a careful and comprehensive search of the subject matter of claims 1-20 for the previous Office action on the merits such that a subsequent Office action on the merits of claims 1-20 should require no further search other than to update the original search (see MPEP §904.03). Applicants submit that updating the original search does not constitute a serious burden, as required by M.P.E.P. §803.

Moreover, Applicants submit that the Examiner has failed to provide an appropriate explanation of the serious burden. Notwithstanding that the Examiner has asserted the two identified groups of invention would be classified in different classification classes, there is no


appropriate statement that the search areas required to examine the invention of Group I would not overlap into the search areas for examining the invention of Group II, and *vice versa*. Moreover, Applicants respectfully submit a complete and adequate search for the identified method of photoresist trimming of claims 2-15 and 17 cannot avoid the class and subclasses directed to the trim gas of claims 19 and 20. Thus, whether the Restriction Requirement is maintained or withdrawn, a complete and adequate search for the recited method will require the Examiner to search the relevant subclasses of class 252 where the trim gas would be classified. Thus, the search for the combination of features recited in the above-identified groups, if not totally co-extensive, would appear to have a very substantial degree of overlap.

Because the search for both groups of invention is substantially the same, Applicants submit that no undue or serious burden would be presented in concurrently examining Groups I and II. Thus, for the above-noted reasons, and consistent with the office policy set forth above in M.P.E.P. §803, Applicants respectfully request that the Examiner reconsider and withdraw the restriction and species requirement in this application.

For all of the above reasons, the Examiner's restriction is believed to be improper. Nevertheless, Applicants have elected, with traverse, the invention defined by Group I, Species I, i.e., claims 2-13, in the event that the Examiner chooses not to reconsider and withdraw the restriction requirement.

Should there be any questions, the Examiner is invited to contact the undersigned at the telephone number below.

Respectfully submitted,
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